

REMARKS

In response to the Office Action dated July 12, 2006, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-47 are pending in this application. By this Amendment, Claim 1 has been amended and Claims 32-47, which were withdrawn from consideration due to a restriction requirement, have been canceled herein without prejudice. Applicants respectfully reserve the right to file one or more divisional applications to non-elected Claims 32-47. Accordingly, Claims 1-31 are now under examination in this case. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein places the application in condition for allowance.

The Examiner has rejected Claims 1-31 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

First, it is the Examiner's apparent belief that the recitation "a reaction product prepared by transesterifying at least one glycerol ester and at least one non-glycerol polyol ester" of Claims 1 and 15 are indefinite because it is unclear whether the at least one non-glycerol polyol ester is a reactant in the transesterifying of the at least one glycerol ester or is it a separate distinct component. Although not necessarily agreeing with the Examiner, Claim 1 has been

amended to recite “a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester”, thus making it perfectly clear that the at least one non-glycerol polyol ester is a reactant.

With respect to Claim 15, it is respectfully submitted that it is not seen where there is any recitation of “a reaction product prepared by transesterifying at least one glycerol ester and at least one non-glycerol polyol ester”. Thus, clarification is respectfully requested.

Second, it is the Examiner’s further belief that the recitations “a major amount of a base oil” and “a minor deposit-inhibiting effective amount of a reaction product ...” as recited in Claims 1 and 15 constitute indefinite subject matter as per the metes and bounds of “major” and “minor”.

It is a well established rule that “whether a claim is invalid for indefiniteness requires a determination whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Morton International Inc. v. Cardinal Chemical Co.*, 28 USPQ2d 1190, 1194-95 (CAFC 1993). Applicants submit that the recitations “a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product ...” as presently recited in independent Claims 1 and 15 are fully definite as to allow one skilled in the art to understand what is claimed when read in light of the specification.

The specification clearly sets forth on page 10, lines 4-7 that the base oil of lubricating viscosity is employed in a major amount by weight *of the lubricating oil composition* of this invention, e.g., an amount of at least 40 wt. %, preferably about 85 to about 98 wt. % and preferably about 90 to about 95 wt. %, based on the total weight of the composition. The specification further sets forth on page 20, line 15 through page 21, line 5 that the reaction

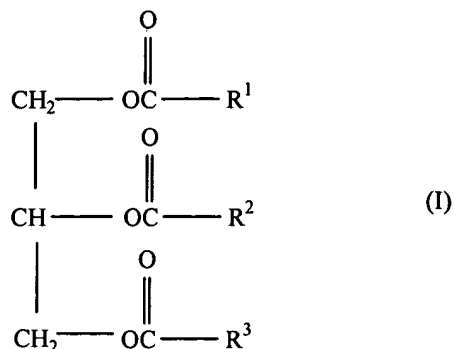
products are generally incorporated into the base oils in a minor deposit-inhibiting effective amount to give a compounded engine oil, e.g., an amount ranging from about 0.05 to about 10 wt. %, preferably from about 0.1 to about 8 wt %, most preferably from about 0.2 to about 5 wt % and more preferably from about 1 to about 5 wt. %, based on the total weight of the composition.

In addition, Examples 1-6 each disclose a lubricating oil composition comprising between 0.1 to 10 weight percent of Cargill AP560 (transesterified product of canola oil and TMP triheptanoate), constituting a minor amount of the reaction product of the lubricating oil composition, with the remainder being CHEVRON 100N (a Group II base oil) and CHEVRON 220N (a Group II base oil), constituting a major amount of the base oil of lubricating viscosity of the lubricating oil composition. Such being the case, one skilled in the art would readily understand the recitations "a major amount by weight of at least one base oil of lubricating viscosity" and "a minor deposit-inhibiting effective amount of a reaction product ...", as presently recited in independent Claims 1 and 15 when analyzing the contents of the specification. Accordingly, the recitations of "a major amount by weight of at least one base oil of lubricating viscosity" and "a minor amount of a reaction product ..." as presently recited in Claims 1 and 15, when read in light of the specification, are believed to be sufficiently clear and definite as to comply with the requirements for definiteness under the second paragraph of 35 U.S.C. §112. For the foregoing reasons, withdrawal of the rejection is respectfully requested.

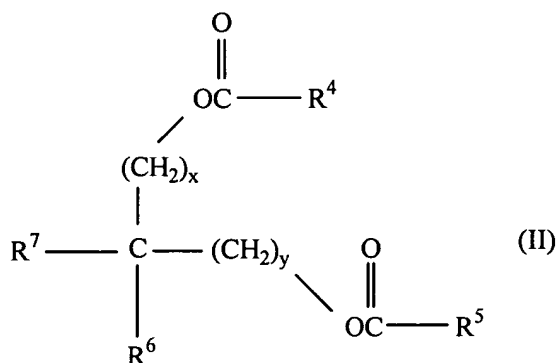
The Examiner has rejected Claims 1-6, 15-16, 18-19 and 26-31 under 35 U.S.C. §102(e) as being anticipated by Chiu et al. U.S. Patent Application Publication No. 2003/0186824 ("Chiu et al.").

The Chiu et al. reference resulted from a filing based on a provisional application. A portion of the Chiu et al. reference upon which the Examiner relies, e.g., Table 2 and certain examples (Examples 8-12), were added on the filing date of the utility application, which was September 24, 2002. The Declaration enclosed with this Amendment establishes conception and reduction to practice of the invention of the pending application as disclosed in the Invention Disclosure T-6172 at least before September 24, 2002, the effective filing date of relevant portions of U.S. Patent Application Publication No. 2003/0186824. The OR# 90946, 90947, 90948, 90829, 90553 and 90554 in the Excel spreadsheet attached to the Invention Disclosure correspond to Examples 1-6 of the subject application as filed and are within the scope of the claims. A copy of the Invention Disclosure, which is redacted to remove the dates, and the accompanying Excel spreadsheet is attached hereto as Exhibit 1.

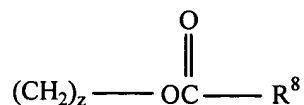
With respect to Examples 1-7 of Chiu et al., which were also relied on by the Examiner, these examples are believed to not anticipate the subject matter of Claims 1-6, 15-16, 18-19 and 26-31. Specifically, Examples 1-7 of Chiu et al. do not disclose a lubricating oil composition within the scope of amended Claim 1, comprising, “(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester”. Examples 1-7 of Chiu et al. also fail to disclose a lubricating oil composition within the scope of Claim 15, comprising, “(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



wherein R^1 , R^2 and R^3 are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



wherein x and y are the same or different and are integers from 1 to 6, R^4 and R^5 are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R^6 and R^7 are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or



wherein z is an integer from 0 to 6 and R^8 is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms”.

Instead, Examples 1-7 of Chiu et al. disclose lubricating oil compositions containing a minor amount of a base oil of lubricating viscosity and relatively high amounts of Agri-Pure

560TM (a transesterified vegetable oil), i.e., amounts greater than 35 weight percent. The lubricating oil compositions of Examples 1-7 of Chiu et al. are therefore not within the scope of the lubricating oil compositions as presently recited in amended Claims 1 and 15.

Accordingly, amended Claims 1-6, 15-16, 18-19 and 26-31 are believed to be patentable over Chiu et al. Therefore, withdrawal of the rejection of Claims 1-6, 15-16, 18-19 and 26-31 under 35 U.S.C. §102(e) is respectfully requested.

The Examiner has rejected Claims 7-14, 17 and 20-25 under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Chiu et al.

As previously stated, the Chiu et al. reference resulted from a filing based on a provisional application. A portion of the Chiu et al. reference upon which the Examiner relies, e.g., Table 2 and certain examples (Examples 8-12), were added on the filing date of the utility application, which was September 24, 2002. The Declaration enclosed with this Amendment establishes conception and reduction to practice of the invention of the pending application as disclosed in the Invention Disclosure T-6172 at least before September 24, 2002, the effective filing date of relevant portions of U.S. Patent Application Publication No. 2003/0186824. The OR# 90946, 90947, 90948, 90829, 90553 and 90554 in the Excel spreadsheet attached to the Invention Disclosure correspond to Examples 1-6 of the subject application as filed and are within the scope of the claims. A copy of the Invention Disclosure, which is redacted to remove the dates, and the accompanying Excel spreadsheet is attached hereto as Exhibit 1.

Examples 1-7 of Chiu et al., which were also relied on by the Examiner, do not provide any disclosure or suggestion of the subject matter of Claims 7-14, 17 and 20-25. Specifically, Examples 1-7 of Chiu et al. do not disclose a lubricating oil composition within the scope of

Claims 7-10, 17, 20 and 21 for at least the same reasons as discussed above with respect to the rejection of Claims 1 and 15, from which Claims 7-10, 17, 20 and 21 ultimately depend.

Therefore, Claims 7-10, 17, 20 and 21 are also believed to be allowable over Chiu et al.

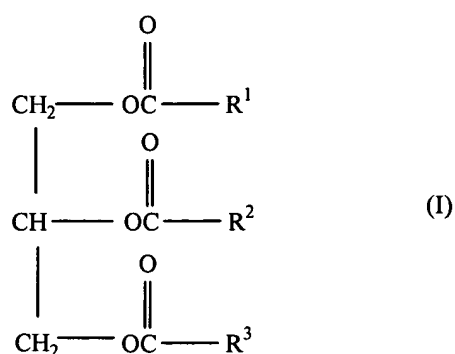
With respect to Claims 11-14 and 22-25, Examples 1-7 of Chiu et al. do not disclose or suggest that a major amount of a base oil of lubricating viscosity can be combined with the reaction product in the specifically recited amounts. The minor deposit-inhibiting effective amounts of the reaction product presently recited in Claims 11-14 and 22-25 range from about 0.05 to about 10 wt. %, based on the total weight of the composition. However, Examples 1-7 of Chiu et al. disclose a lubricating oil compositions containing a minor amount of a base oil of lubricating viscosity and relatively high amounts of Agri-Pure 560TM (a transesterified vegetable oil), i.e., amounts greater than 35 weight percent. Accordingly, the lubricating oil compositions of Examples 1-7 of Chiu et al. provide no disclosure or suggestion of the specifically recited amounts of the reaction product in Claims 11-14 and 22-25, much less a lubricating oil composition containing the specifically recited amounts of the reaction product together with a major amount of a base oil of lubricating viscosity.

Accordingly, Claims 7-14, 17 and 20-25 are believed to be patentable over Chiu et al. Therefore, withdrawal of the rejection of Claims 7-14, 17 and 20-25 is respectfully requested.

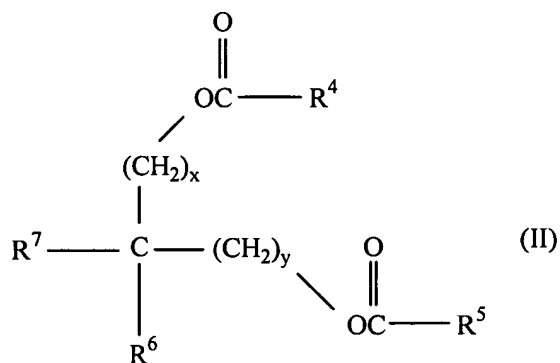
The Examiner has rejected Claims 1-10, 15-21 and 26-31 under 35 U.S.C. §102(b) as being anticipated by Culpon Jr. U.S. Patent No. 5,151,205 ("Culpon"). The rejection of Claims 1-10, 15-21 and 26-31 under 35 U.S.C. §102(b) is respectfully traversed.

In contrast to the presently claimed invention, Culpon fails to disclose a lubricating oil composition within the scope of amended Claim 1, comprising, *inter alia*, "a minor deposit-

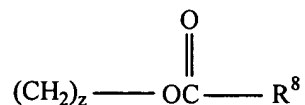
inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester”. Culpon also fails to disclose a lubricating oil composition within the scope of Claim 15, comprising, *inter alia*, “a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



wherein R¹, R² and R³ are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



wherein x and y are the same or different and are integers from 1 to 6, R⁴ and R⁵ are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R⁶ and R⁷ are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or



wherein z is an integer from 0 to 6 and R⁸ is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms”.

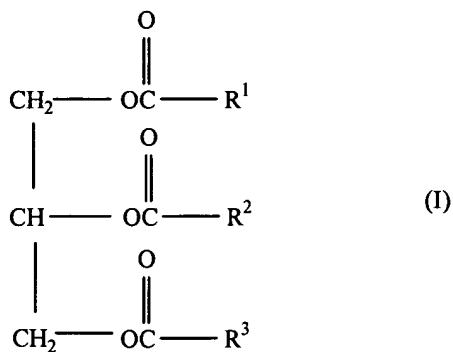
Instead, Culpon discloses in Examples 1-3, which the Examiner relies upon in rejecting the claims, lubricating oil compositions containing a base oil and a TMP Ester 1 or TMP Ester 2 together with various additives. Culpon further discloses that the TMP Ester 1 is a trimethylol propane ester of C₈-C₁₀ normal carboxylic acid while TMP Ester 2 is a trimethylol propane ester of C₇ and C₉ normal carboxylic acids. The TMP Ester 1 and TMP Ester 2 are not within the scope of the reaction product as presently recited in amended Claims 1 and 15.

Accordingly, since Culpon does not disclose a reaction product as presently recited in amended Claims 1 and 15, amended Claims 1-10, 15-21 and 26-31 are not anticipated by Culpon. Accordingly, withdrawal of the rejection of Claims 1-10, 15-21 and 26-31 under 35 U.S.C. §102(b) is respectively requested.

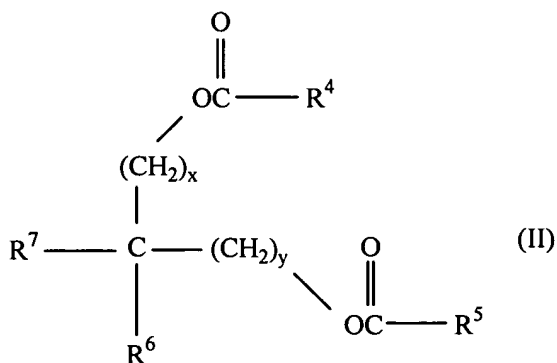
The Examiner has rejected Claims 11-14 and 22-25 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Culpon.

The foregoing deficiencies of Culpon discussed above with respect to the rejections of Claims 1 and 15, from which Claims 11-14 and 22-25 ultimately depend, apply with equal force to this rejection. As Culpon nowhere discloses a reaction product as presently recited in amended Claims 1 and 15, Culpon certainly cannot disclose the limitations of dependent Claims 11-14 and 22-25 for at least the same reasons. Accordingly, rejected Claims 11-14 and 22-25 are believed to possess novel subject matter relative to Culpon.

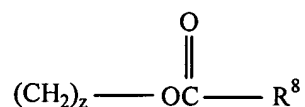
There is likewise no disclosure or suggestion in Culpon of a lubricating oil composition within the scope of amended Claim 1, comprising, *inter alia*, “a minor deposit-inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester”. Additionally, there is likewise no disclosure or suggestion in Culpon of a lubricating oil composition within the scope of Claim 15, comprising, *inter alia*, “a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



wherein R¹, R² and R³ are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



wherein x and y are the same or different and are integers from 1 to 6, R⁴ and R⁵ are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R⁶ and R⁷ are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or

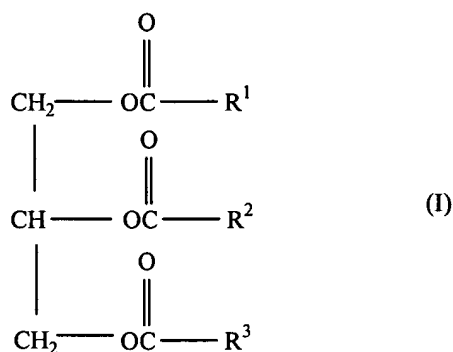


wherein z is an integer from 0 to 6 and R⁸ is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms”.

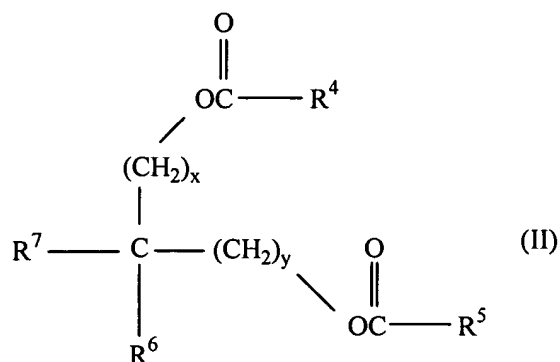
Instead, Culpon merely discloses in Examples 1-3 lubricating oil compositions containing a base oil and a TMP Ester 1 or TMP Ester 2 together with various additives. Culpon further discloses that the TMP Ester 1 is a trimethylol propane ester of C₈-C₁₀ normal carboxylic acid while TMP Ester 2 is a trimethylol propane ester of C₇ and C₉ normal carboxylic acids. Nothing in Culpon would lead one skilled in the art to modify the lubricating oil compositions disclosed therein and arrive at the lubricating oil compositions containing a minor deposit-inhibiting effective amount of the specifically recited reaction products of amended Claims 1 and 15, from which Claims 11-14 and 22-25 depend. Further, nothing in Culpon would lead one skilled in the art to modify TMP Esters 1 and 2, present in the lubricating oil compositions in amounts of 20 weight percent and higher, as disclosed therein and arrive at the lubricating oil compositions containing the specifically recited reaction products present in amounts of less than or equal to 10 weight percent, as generally recited in Claims 11-14 and 22-25. As such, Claims 11-14 and 22-25 are also believed to be non-obvious, and therefore patentable, over Culpon.

The Examiner has rejected Claims 1-11, 15, 18-22 and 26-31 under 35 U.S.C. §102(b) as being anticipated by Kodali et al. U.S. Patent No. 6,278,006 (“Kodali et al.”).

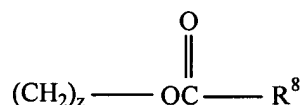
In contrast to the presently claimed invention, Kodali et al. fails to disclose a lubricating oil composition within the scope of amended Claim 1, comprising, “(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester”. Kodali et al. also fails to disclose a lubricating oil composition within the scope of Claim 15, comprising, “(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



wherein R^1 , R^2 and R^3 are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



wherein x and y are the same or different and are integers from 1 to 6, R⁴ and R⁵ are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R⁶ and R⁷ are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or



wherein z is an integer from 0 to 6 and R⁸ is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms”.

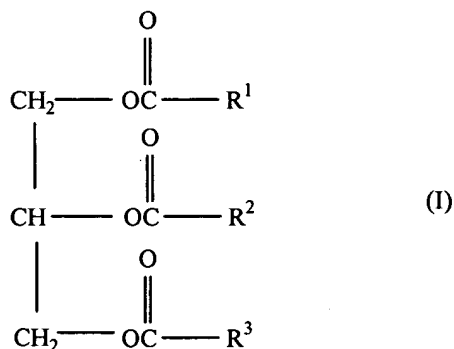
Instead, Kodali et al. simply disclose base oils prepared by transesterifying a first glycerol polyol ester with a second non-glycerol polyol ester. Additionally, Examples 3-5 of Kodali et al., which the Examiner relies upon in rejecting Claims 1-11, 15, 18-22 and 26-31, simply disclose (1) a general transesterification procedure (Example 3); (2) transesterification of vegetable oils with short chain fatty acid esters (Example 4); and (3) characterization of the transesterified oil products (Example 5). Accordingly, Kodali et al. does not disclose all of the elements and limitations of the claimed invention. For the foregoing reasons, amended Claims 1-11, 15, 18-22 and 26-31 are believed to be patentably distinct over Kodali et al. Thus, withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claims 12 and 23 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Kodali et al.

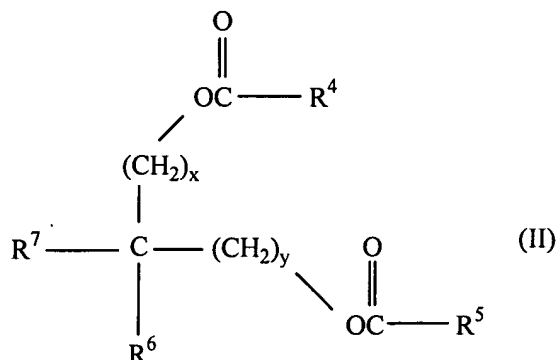
The foregoing deficiencies of Kodali et al. discussed above with respect to the rejections of Claims 1 and 15, from which Claims 12 and 23 ultimately depend, apply with equal force to this rejection. As Kodali et al. nowhere disclose a lubricating oil composition as presently recited in amended Claims 1 and 15, Kodali et al. certainly cannot disclose the limitations of

dependent Claims 12 and 23 for at least the same reasons. Accordingly, rejected Claims 12 and 23 are believed to possess novel subject matter relative to Kodali et al.

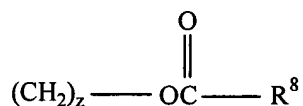
There is likewise no disclosure or suggestion in Kodali et al. of a lubricating oil composition within the scope of amended Claim 1, comprising, “(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester”. Additionally, there is likewise no disclosure or suggestion in Kodali et al. of a lubricating oil composition within the scope of Claim 15, comprising, “(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



wherein R^1 , R^2 and R^3 are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



wherein x and y are the same or different and are integers from 1 to 6, R^4 and R^5 are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R^6 and R^7 are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or



wherein z is an integer from 0 to 6 and R^8 is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms”.

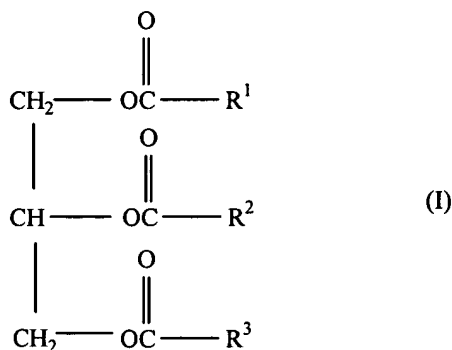
Instead, Kodali et al. simply discloses base oils for use in industrial applications prepared by transesterifying a first glycerol polyol ester with a second non-glycerol polyol ester. At no point is there any suggestion, motivation or even a hint in Kodali et al. of employing a minor deposit-inhibiting effective amount of the specifically recited reaction product in a lubricating oil composition much less a lubricating oil composition containing (a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the specifically recited reaction product. Thus, nothing in Kodali et al. would lead one skilled in the art to modify the base oils for use in industrial applications prepared by transesterifying a first glycerol polyol ester with a second non-glycerol polyol ester as disclosed therein and arrive at the specifically recited lubricating oil compositions of amended Claims 1 and 15, from which Claims

12 and 23 depend. Further, nothing in Kodali et al. would lead one skilled in the art to modify the base oils for use in industrial applications prepared by transesterifying a first glycerol polyol ester with a second non-glycerol polyol ester as disclosed therein and arrive at the lubricating oil composition containing (a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the specifically recited reaction product wherein the minor deposit-inhibiting effective amount of the reaction product is about 0.1 to about 8 wt. %, based on the total weight of the composition as recited in Claims 12 and 23. As such, Claims 12 and 23 are also believed to be non-obvious, and therefore patentable, over Kodali et al.

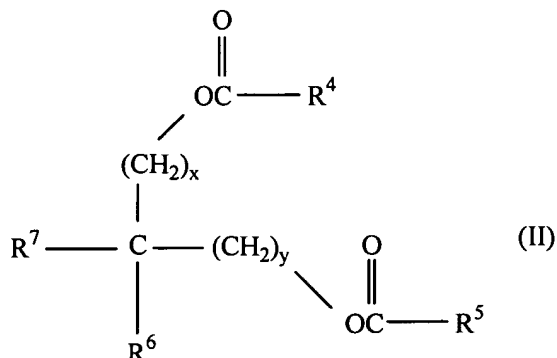
In the Office Action, the Examiner states “[i]t would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant’s component (b) within applicant’s particular claimed concentration range since such directly falls within the broad disclosure of the reference.” This wholly unsupported allegation cannot possibly serve as a basis for this rejection. Nothing in Kodali et al. provides any suggestion or motivation to combine a (a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the specifically recited reaction product to form the claimed lubricating oil compositions, much less the lubricating oil compositions containing the specifically recited minor deposit-inhibiting effective amounts of the reaction products. However, if it is the Examiner’s position that Kodali et al. provides such suggestion or motivation to form the claimed lubricating oil composition, the Examiner is respectfully requested to identify with particularity (i.e., by column and line) where in Kodali et al. such suggestion or motivation can be found.

The Examiner has rejected Claims 1-31 under 35 U.S.C. §103(a) as being unpatentable over Lal U.S. Patent No. 5,338,471 ("Lal") in view of anyone of the following: Chiu et al or Culpon or Kodali et al.

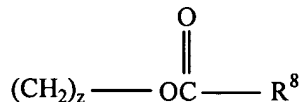
As acknowledged by the Examiner, nothing in Lal discloses or suggests a lubricating oil composition within the scope of amended Claim 1, comprising, "(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester". As further acknowledged by the Examiner, there is no disclosure or suggestion in Lal of a lubricating oil composition within the scope of Claim 15, comprising, "(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



wherein R^1 , R^2 and R^3 are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



wherein x and y are the same or different and are integers from 1 to 6, R⁴ and R⁵ are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R⁶ and R⁷ are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or



wherein z is an integer from 0 to 6 and R⁸ is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms”.

Rather, Lal simply discloses a composition comprising (A) at least one vegetable or synthetic triglyceride oil; (B) esters from the transesterification of at least one animal or vegetable oil triglyceride with an alcohol or phenol; (C) a pour point depressant; (D) at least one performance additive and optionally (E) at least one oil selected from the group consisting of (1) synthetic ester base oil, (2) a mineral oil; (3) a polyalphaolefin; and (4) a vegetable oil. It is not seen where Lal provides any suggestion, motivation or even a hint of a lubricating oil composition containing (a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the specifically recited reaction product. Thus, nothing in Lal that would lead one skilled in the art to modify the compositions disclosed therein and arrive at the claimed lubricating oil composition containing (a) a major amount of a base oil of

lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the specifically recited reaction product.

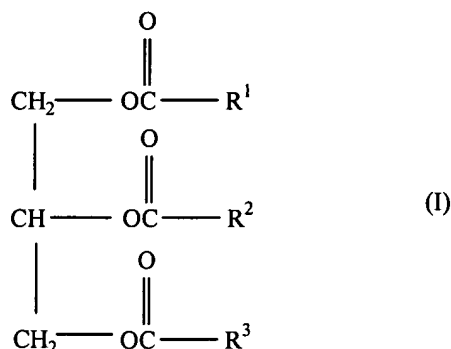
The secondary references do not cure and are not cited as curing the deficiencies of Lal. Chiu et al. simply discloses relatively high amounts of a transesterified vegetable oil together with minor amounts of a base oil of lubricating viscosity. Thus, even by combining Lal with Chiu et al. one skilled in the art would not even arrive at the claimed lubricating oil compositions. Culpon merely discloses in Examples 1-3 lubricating oil compositions containing a base oil and a TMP Ester 1 or TMP Ester 2 together with various additives. Culpon further discloses that the TMP Ester 1 is a trimethylol propane ester of C₈-C₁₀ normal carboxylic acid while TMP Ester 2 is a trimethylol propane ester of C₇ and C₉ normal carboxylic acids. Thus even by combining Lal with Culpon, one skilled in the art would not even arrive at the claimed lubricating oil compositions.

Kodali et al. simply discloses base oils for use in industrial applications prepared by transesterifying a first glycerol polyol ester with a second non-glycerol polyol ester, which may contain other additives. At no point is there any suggestion, motivation or even a hint in Kodali et al. that the oil can be combined with a major amount of a base oil of lubricating viscosity in a minor deposit-inhibiting effective amount to form a lubricating oil composition such that the composition provides deposit protection in addition to high antiwear and oxidation-corrosion protection. Thus, nothing in Kodali et al. would lead one skilled in the art to modify the compositions of Lal by looking to the disclosure of Kodali et al. and arrive at the claimed lubricating oil compositions. As such, Claims 1-31 are believed to possess patentable subject

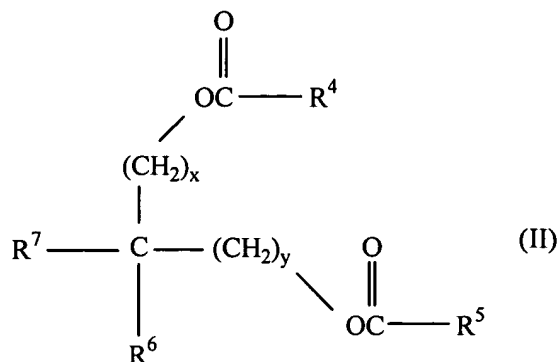
matter over Lal in view of Chiu et al or Culpon or Kodali et al. and withdrawal of the rejection is respectfully requested.

The Examiner has provisionally rejected Claims 1-31 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-14 of co-pending Application No. 10/674,692. This rejection is respectfully traversed.

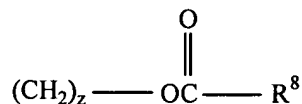
When analyzing a reference employed in an obvious-type double patenting rejection, the guidelines for the analysis parallels that of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). Nowhere does co-pending Application No. 10/674,692 disclose or suggest a lubricating oil composition within the scope of amended Claim 1, comprising, *inter alia*, “a minor deposit-inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester”. Additionally, nor does co-pending Application No. 10/674,692 disclose or suggest a lubricating oil composition within the scope of Claim 15, comprising, *inter alia*, “a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



wherein R^1 , R^2 and R^3 are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



wherein x and y are the same or different and are integers from 1 to 6, R^4 and R^5 are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R^6 and R^7 are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or



wherein z is an integer from 0 to 6 and R^8 is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms”.

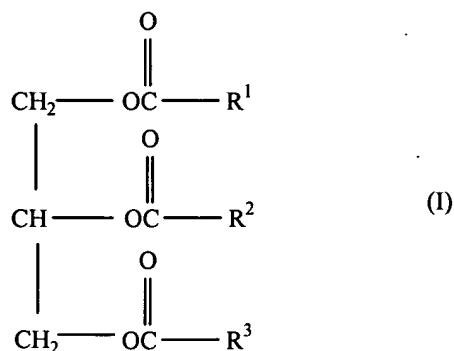
Rather, Claims 1-14 of co-pending Application No. 10/674,692, which the Examiner relies upon in rejecting the presently recited claims under the judicially created doctrine of obviousness-type double patenting, discloses a low phosphorous or phosphorous-free lubricating oil composition comprising (a) a major amount of base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of at least one polyol ester of the recited formula; wherein the composition has a phosphorous content not exceeding 0.08 by weight, based on the total weight of the composition. There is no disclosure or suggestion in co-pending Application No. 10/674,692 of the specifically recited reaction product. Instead, co-pending Application No.

10/674,692 merely discloses a low phosphorous or phosphorous-free lubricating oil composition employing a minor deposit-inhibiting effective amount of at least one polyol ester of the recited formula; wherein the composition has a phosphorous content not exceeding 0.08 by weight, based on the total weight of the composition. Thus, nothing in co-pending Application No. 10/674,692 would lead one skilled in the art to modify the lubricating oil composition disclosed therein and arrive at the claimed lubricating oil compositions containing, *inter alia*, the specifically recited reaction product of Claims 1-31. The presently recited claims to a lubricating oil composition are therefore considered to be patentably distinct from the claims to a lubricating oil composition of co-pending Application No. 10/674,692. Accordingly, the rejection of Claims 1-31 under the judicially created doctrine of obviousness-type double patenting is believed to be unwarranted and withdrawal of the rejection is respectfully requested.

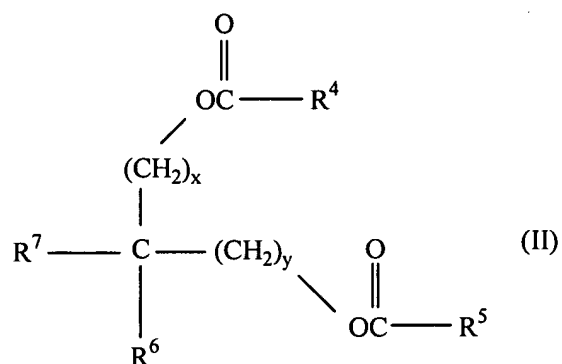
The Examiner has provisionally rejected Claims 1-31 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-46 of co-pending Application No. 11/046,994. This rejection is respectfully traversed.

As previously stated, the guidelines for the analysis of a reference employed in an obvious-type double patenting rejection parallels that of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). Nowhere does co-pending Application No. 11/046,994 disclose or suggest a lubricating oil composition within the scope of amended Claim 1, comprising, *inter alia*, “a minor deposit-inhibiting effective amount of a reaction product prepared by transesterifying at least one glycerol ester with at least one non-glycerol polyol ester”. Additionally, nor does co-pending Application No. 11/046,994 disclose or suggest a lubricating oil composition within the scope of Claim 15, comprising, *inter*

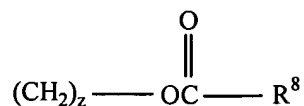
alia, “ a minor deposit-inhibiting effective amount of a reaction product of at least one first polyol ester of the general formula:



wherein R^1 , R^2 and R^3 are independently aliphatic hydrocarbyl moieties having 4 to about 75 carbon atoms; and at least one second polyol ester of the general formula:



wherein x and y are the same or different and are integers from 1 to 6, R^4 and R^5 are independently aliphatic hydrocarbyl moieties having 4 to 24 carbon atoms and R^6 and R^7 are independently hydrogen, an aliphatic hydrocarbyl moiety having 1 to 10 carbon atoms or



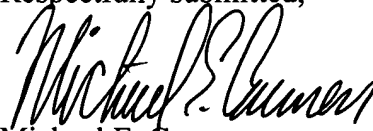
wherein z is an integer from 0 to 6 and R^8 is an aliphatic hydrocarbyl moiety having 4 to 24 carbon atoms”.

Rather, Claims 1-46 of co-pending Application No. 11/046,994, which the Examiner relies upon in rejecting the presently recited claims under the judicially created doctrine of obviousness-type double patenting, discloses a lubricating oil composition comprising (a) at least one Fischer-Tropsch derived lubricating base oil characterized as having a kinematic viscosity of about 2 to about 5 centistoke (cSt) at 100°C; and (b) at least one polyol ester. There is no disclosure or suggestion in co-pending Application No. 11/046,994 of the specifically recited reaction product. Instead, co-pending Application No. 11/046,994 merely discloses a lubricating oil composition employing at least one polyol ester. Thus, nothing in co-pending Application No. 11/046,994 would lead one skilled in the art to modify the lubricating oil composition disclosed therein and arrive at the claimed lubricating oil compositions containing, *inter alia*, the specifically recited reaction product of Claims 1-31. The presently recited claims to a lubricating oil composition are therefore considered to be patentably distinct from the claims to a lubricating oil composition of co-pending Application No. 11/046,994. Accordingly, the rejection of Claims 1-31 under the judicially created doctrine of obviousness-type double patenting is believed to be unwarranted and withdrawal of the rejection is respectfully requested.

Appln. No. 10/674,643
Response dated October 12, 2006
Response to Office Action dated July 12, 2006

For the foregoing reasons, amended Claims 1-31 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen", written in a cursive style.

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